

REMARKS

At the time of the Final Office Action dated May 5, 2005, claims 1-11 were pending and rejected in this application. Claim 10 has been amended to clarify the invention recited therein, and Applicant respectfully submits that the present Amendment does not generate any new matter issue.

CLAIMS 1-2 AND 7-8 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY APPLICANT'S ADMITTED PRIOR ART (HEREINAFTER THE ADMITTED PRIOR ART)

On pages 2 and 3 of the Office Action, the Examiner asserted that the Admitted Prior Art discloses a method and machine readable storage corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference. As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.

In the response filed December 27, 2004, Applicant argued that the Admitted Prior Art fails to identically disclose the claimed interactive user interface element, which upon activation,

performs a pre-defined window manipulation operation. In response to this argument, on page 7 of the Final Office Action, the Examiner asserted the following:

Thus, responsive to the selection and activation of the user interface element in the pull-down menu, a window manipulation operation is performed (the focus change) upon an inactive open document window corresponding to the activated interactive user interface element.

Thus, the Examiner has apparently determined the claimed term of "window manipulation operation" to be identically disclosed by the "focus change." Claim construction analysis begins with the words of the claims, and absent an express intent to impart a novel meaning to the claims terms, the words take on the full breadth of the ordinary and customary meanings attributed to them by those of ordinary skill in the art.

A review of the statement of the rejection and the Examiner's response to Applicant's prior arguments does not yield an explanation as to why the Examiner believes the claimed term of "window manipulation operation" is identically disclosed by the disclosed focus change. The Examiner has not put forth any factual evidence that that the term "window manipulation operation" has been attributed a meaning of "focus change" by those of ordinary skill in the art. Furthermore, the Examiner has not undertaken a word-for-word deconstruction and interpretation of the term "window manipulation operation."

An interpretation of the plain language of the term "window manipulation operation" yields an operation that manipulates a window. Dictionary definitions of the term "manipulate" include "to manage or utilize skillfully"¹ and "to adapt or change (accounts, figures, etc.) to suit

¹ See Merriam-Webster Online Diction (www.m-w.com).

one's purpose or advantage."² Thus, one possible interpretation of the phrase "window manipulation operation" yields an operation that utilizes or changes a window. The Examiner's asserted "focus change," however, does not meet this limitation.

The "change" that occurs in the asserted "focus change" is a change of the focus of the operating system from one window to another. The window does not change, but instead, the focus of the operating system changes. Moreover, the window is not utilized as a result of the focus change. The focus change may be a potential precursor to utilization of the window, but the focus change alone does not utilize the window.

Applicant notes that a focus change to a window, which is partially or fully hidden by other windows, may cause that window to be placed in the forefront of other windows. On that basis, the Applicant presumes that the Examiner may argue that such an operation inherently discloses the claimed "window manipulation operation." The Examiner cannot argue that the Admitted Prior Art expressly teaches the claimed "window manipulation operation" since the Admitted Prior Art is silent with regard to a window manipulation operation; and therefore, the Examiner would have to rely on an inherency argument.

Such an reliance upon the doctrine of inherency to disclose the claimed window manipulation operation, however, would be misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of

² Webster's College Dictionary, Random House, 1995, pg. 825.

circumstances is not sufficient to establish inherency.³ To establish inherency, the extrinsic evidence must make clear that the missing function must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁴ As apparent from Fig. 1 of the Admitted Prior Art, a focus change to window 220D would not result in an operation that places window 220D in the forefront of the other windows since window 220D is already in the forefront. Thus, the function of placing a window in the forefront of other windows is not necessarily present with the focus change of the Admitted Prior Art. Thus, a finding that the claimed window manipulation operation would be inherently disclosed by the Admitted Prior Art would be improper. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

Since the Admitted Prior Art fails to identically disclose the claimed window manipulation operation within the meaning of 35 U.S.C. § 102, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1-2 and 7-8 under 35 U.S.C. § 102 for anticipation based upon the Admitted Prior Art.

³ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁴ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

**CLAIMS 3-6 AND 9-11 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON THE ADMITTED PRIOR ART IN VIEW OF BEAUDET ET AL., U.S. PATENT NO. 5,491,795
(HEREINAFTER BEAUDET)**

On pages 3-7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the Admitted Prior Art in view of Beaudet to arrive at the claimed invention. This rejection is respectfully traversed.

At the outset, Applicant notes that the Examiner did not discuss claims 10-11 in the statement of the rejection with regard to the rejection based upon the combination of the Admitted Prior Art in view of Beaudet. Instead, the Examiner separately rejected claims 10-11 for obviousness based upon the Admitted Prior Art alone. Therefore, Applicant proceeds on the basis that only claims 3-6 and 9 were intended to be rejected based upon the combination of the Admitted Prior Art in view of Beaudet.

With regard to the asserted motivation combine the Admitted Prior Art in view of Beaudet, the Examiner stated:

One would be motivated to make such a combination due to the fact that the pull-down menu presents a list of windows to the user, as does the window control management system of Beaudet. Therefore, in order to save space on screen and allow for an easily accessible window menu, one would be motivated to combine the admitted prior art and Beaudet.

Applicant respectfully submits that the Examiner has not asserted a proper motivation to combine.

The requisite motivation to combine under 35 U.S.C. § 103 is cannot be based solely upon the Examiner's reasoning and stated motivation. As a general matter, "virtually all [inventions] are combinations of old elements."⁵ If it were permissible to create a motivation to combine without factual support from the applied prior art, but instead, based on the Examiner's reasoning and stated motivation guided by hindsight reconstruction of the claimed invention, then nearly every invention would be unpatentable. However, the Examiner's reasoning has been contaminated by the teachings of Applicant's invention, and it has been held that one having ordinary skill in the art does not have the benefit of hindsight of Applicant's invention.⁶ As such, the motivation to modify the prior art must come from the prior art.⁷

The Examiner's assertion of "to save space on screen and allow for an easily accessible window menu" is a generalization that that could apply to nearly any invention that involves on-screen windows.⁸ Moreover, the Examiner has failed to establish this motivation to combine is derived from a teaching or suggestion in the prior art or the general knowledge of a person of ordinary skill in the art in the field of the invention.

With regard to independent claim 4, the Examiner asserted that:

⁵ In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).

⁶ Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

⁷ There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); ATD Corp., 159 F.3d at 546, 48 USPQ2d at 1329; Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.").

⁸ A generalization does not establish the requisite motivation to modify a specific reference in a specific manner to arrive at a specifically claimed invention. In re Deuel, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995).

the admitted prior art ... inherently teaches an event handler configured to post pre-defined window manipulation events to inactive open document windows. (Emphasis added)

As articulated by the Honorable Board of Patent Appeals and Interferences in In re Schricker,⁹:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner, however, did not discharge the burden of indicating where the basis for the Examiner's inherency theory can be found in the prior art. Thus, the Examiner has not established that these limitations are inherently disclosed by the Admitted Prior Art.

With regard to the Examiner's comments on page 8 of the Final Office Action, i.e., "the manipulation events (focus control) of the inactive windows in Figure 1 must involve an event handler ...," is factually unsupported. Furthermore, since as previously argued, the Admitted Prior Art fails to teach a windows manipulation operation, there is no "must" need for an event handler that posts window manipulation events to inactive document windows.

Therefore, for the reasons stated above, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. §103. Thus, Applicant respectfully solicits withdrawal of the imposed rejection of claims 3-6 and 9 for obviousness based upon the Admitted Prior Art in view of Beaudet.

⁹ 56 USPQ2d 1723, 1725 (BPAI 2000)

CLAIMS 10 AND 11 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED

UPON THE ADMITTED PRIOR ART

On pages 6 and 7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the Admitted Prior Art to arrive at the claimed invention. This rejection is respectfully traversed.

Independent claim 10 has been amended to clarify that the corresponding interactive user interface elements are positioned separately from the listing of selected operating system services. *Assuming arguendo* that the window list 140 inherently discloses a list of selected operating system services and each element of the list is an interactive user interface element, the Admitted Prior Art still fails to teach or suggest the claimed invention, since the interactive user interface elements are not positioned separately from the listing of selected operating system services, as recited in amended claim 10. Instead, based upon the Examiner's construction of the terms "corresponding interactive user interface elements" and "listing of selected operating system services," these features are one and the same. Therefore, Applicant respectfully solicits withdrawal of the imposed rejection of claims 10 and 11 under 35 U.S.C. §103 for obviousness based upon the Admitted Prior Art.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



Steven M. Greenberg
Registration No. 44,725
Christopher & Weisberg, P.A.
200 E. Las Olas Blvd., Suite 2040
Fort Lauderdale, FL 33301
Tel: (954) 828-1488
Facsimile: (954) 828-9122
Customer Number 46320